

## **REMARKS**

Claims 22-40 and 42-69 are pending in the Application. The Advisory action mailed March 30, 2010 ("Advisory Action") maintained the rejections of the final Office action ("Final OA") mailed January 5, 2010. Claims 22, 47, and 60 are amended by this response.

Claims 22, 47, and 60 are independent claims. Claims 23-40 and 42-46, 48-59, and 61-69 depend, respectively, from independent claims 22, 47, and 60. Applicants respectfully request reconsideration of claims 22-40 and 42-69, in view of the following remarks.

As an initial matter, Applicants note that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is **essential** that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, USPTO personnel should state all reasons and bases for rejecting claims in the first Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, USPTO personnel should indicate how rejections may be overcome and how problems may be resolved. **A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.**

M.P.E.P. § 2106(II) (emphasis added).

As such, the Applicants assume, based on the goals of patent examination noted above, that the current Office Action sets forth "all reasons and bases" for rejecting the claims.

Applicants respectfully request reconsideration and withdrawal of the rejections of Office action mailed January 5, 2010 maintained by the Advisory action, for at least the reasons set forth below.

### **Amendments to the Specification**

Applicants have amended the Specification as shown above to update information about related applications. Applicants respectfully submit that these amendments do not add new matter.

### **Amendments to the Claims**

Claims 22, 47, and 60 have been amended to correct a noted minor grammatical error. Support for the amendments to claims 22, 47, and 60 may be found, at least, at pages 271-290 and Fig. 56a of the Application. Applicants respectfully submit that the amendments to claims 22, 47, and 60 do not add new matter.

### **Rejections of Claims**

Claims 22, 27, 28, 34, 37-40, 43, 45-47, 52-55, 57-60, and 65-69 were rejected under 35 U.S.C. §102(e) as being anticipated by Baum, *et al.* (US 5,761,281, hereinafter "Baum"). Claims 23-25, 29-33, 44, 48-51, 56, and 61-63 were rejected under 35 U.S.C. §103(a) as being unpatentable over Baum in view of Henley, *et al.* (US 5,526,353, hereinafter "Henley"). Claims 26 and 64 were rejected under 35 U.S.C. §103(a) as being unpatentable over Baum and Henley, in view of Lev, *et al.* (US 5,729,544, hereinafter "Lev"). Claim 35 was rejected under 35 U.S.C. §103(a) as being unpatentable over Baum in view of Barak (US 5,764,741). Claim 36 was rejected under 35 U.S.C. §103(a) as being unpatentable over Baum in view of Fleischer, III *et al.* (US 5,592,541, hereinafter "Fleischer, III"). Claim 42 was rejected under 35 U.S.C. §103(a) as being unpatentable over Baum in view of Sharman (US 5,774,854). Applicants respectfully traverse the rejections for the reasons set forth during prosecution. Notwithstanding, Applicants have amended claims 22, 47, and 60 to clarify aspects of the claims, rendering the rejections of the Final OA moot.

**I. Baum Does Not Anticipate Claims 22, 27, 28, 34, 37-40, 43, 45-47, 52-55, 57-60, And 65-69**

Claims 22, 27, 28, 34, 37-40, 43, 45-47, 52-55, 57-60, and 65-69 were rejected under 35 U.S.C. §102(e) as being anticipated by Baum. Applicants respectfully traverse the rejection.

With regard to the anticipation rejections, MPEP 2131 states, “[a] claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, **in a single prior art reference.**” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). “The **identical** invention must be shown in as complete detail as is contained in ... the claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added). Further, “[t]he elements **must be arranged as required by the claim**, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required.” MPEP § 2131 (citing *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990); emphasis added).

Applicants respectfully maintain that Baum relates to transmission of data, not voice, over voice band circuits of a telephone company network to a “network access server.” See Abstract and Fig. 1. Call originators are linked via modem to telephone lines in the form of analog modem signals. See *id.* at col. 7, lines 38 to col. 8, line 2. The analog modem signals are digitized by the telephone company network and placed into individual DS0 channels of a T1 span, and fed into the “network access server.” See *id.* at col. 8, lines 2-14. Each DS0 carries a digital representation of one analog voice channel carrying a modem signal from a call originator. The modem signals are received by the “network access server,” the “network access server” uses appropriate protocol parameters associated with control signals from the incoming call to configure itself, and the data received from the call originator is transmitted over a network. See *id.* at col. 8, lines 42-60.

**With regard to independent claim 22**, Applicants respectfully submit that claim 22 now recites, in part, “[a] communication system controller comprising: ... interface circuitry for communicating, with an information transmission device, information

requesting setup of a call and parameters for configuring the information transmission device, wherein the parameters for configuring the information transmission device comprise information specifically related to the conversion, by the information transmission device, of digitized voice information into an analog voice signal, and of an analog voice signal into digitized voice information.” Applicants respectfully submit that the Baum does not teach, suggest, or disclose at least this aspect of Applicants’ claim 22. Applicants respectfully submit that amended claims 47 and 60 recite similar features.

The Final OA rejected this aspect of Applicants’ claim 22 stating, at pages 2-3:

**Regarding claim 22**, Baum et al. disclose a communication system controller comprising: ... wherein the parameters for configuring the information transmission device comprise information related to the conversion of digitized voice information into an analog voice signal, and an analog voice signal into digitized voice information (**see Fig. 1; modem inside network server is configured with configuration parameter (claim 1) to support conversion between digital and analog as shown in Fig. 1)(data as taught by Baum before being placed on the T1 line is in analog from [sic] and transmitted on the telephone lines 40, 42, and 44. The calls from the call originators are then converted to digital signals (calls are digitized) and placed into the T1 line (see col. 8, lines 1-8))((call signaling is for voice service (col. 19 lines 30-31) and the signaling bits (for T1 DS0) translate directly into E and M signaling (signaling for voice service) (col. 19 lines 65-66);**

(emphasis in original)

The Final OA asserted that the “modem inside network server is configured with configuration parameter ... to support conversion between digital and analog as shown in Fig. 1.” Applicants respectfully submit that Fig. 1 of Baum does not teach, suggest, or disclose conversion of “digitized voice information into an analog voice signal, and of an analog voice signal into digitized voice information,” as required by amended claim 22. Applicants have amended claim 22 to clarify that the required conversion is “by the information transmission device,” and respectfully submit that Fig. 1 of Baum fails to teach, suggest, or disclose that the “modem” in the “network access server 30” performs

such conversion. Further, claim 1 of Baum similarly provides insufficient support for the rejection of the features of Applicants' claim 22.

Applicants also respectfully submit that that the cited portions of Baum at col. 8, lines 1-8, col. 19, lines 30-31, and col. 19, lines 65-66 do not teach, suggest, or disclose that the "modem inside network [access] server [30]" converts "digitized voice information into an analog voice signal, and of an analog voice signal into digitized voice information," as required by claim 22." Further, Baum does not teach, suggest, or disclose the configuration of the "modem" of the "network access server 30" to perform the conversion, as required by claim 22. Applicants respectfully maintain that the only identification by the Office of any teaching of conversion between digital and analog is located in the "telephone company network 50" of Fig. 1. See *id.* at col. 8, lines 1-8. Applicants respectfully submit that claim 22 is allowable for at least an additional reason.

Applicants' claim 22 also recites, in part, "operational software executable by the at least one processor, the operational software causing the at least one processor to produce the parameters for configuring the information transmission device based upon the information requesting setup of a call." The Final OA rejected this aspect of Applicants' claim 22 at page 3, stating:

**Regarding claim 22**, Baum et al. disclose ... a communication system controller comprising: ... at least one processor communicatively coupled to the interface circuitry (**see Fig. 7A-B; CPU 633 in the network applicant module 82**); and operational software executable by the at least one processor, the operational software (**see col. 9 lines 24-32; the network application module 82 functions as an interface and includes software to process control signals to configure the modem**) causing the at least one processor to produce the parameters for configuring the information transmission device based upon the information requesting setup of a call (**see col. 30 lines 47-50; protocol parameters for configuration of the modem are produced by converting the control signals; where the control signals is extracted from the an incoming call; the call setup and the modem configuration are performed using the extracted control signals (see col. 3 lines 1-12))**...

(emphasis in original)

The Office cites Baum at col. 30, lines 47-50 as teaching that the “CPU 633” of Baum, which the Office identified as teaching Applicants’ claimed “at least one processor,” produces the parameters for configuring the “modem” of the “network application module 82,” which the Office has asserted teaches Applicants’ claimed “information transmission device.” Applicants respectfully disagree. Applicants now address Baum at col. 30, lines 47-50, which states:

Between  $t_2$  and time X, the receiving modem 447 is receiving the multi-frequency tones and is decoding the tones and converting these control signals into protocol parameters for configuration of the modem. (See FIGS. 8, 10, 11). In this example, the multi-frequency tones include a separate control signal indicating that a credit card verification technique is being used, and the network application module 82 retrieves a setmode command block having a field with a command associated with general credit card verification transmission protocols.

Applicants respectfully note that the cited portion of Baum shown above teaches that the “receiving modem 447” receives and decodes tones and converts these “control signals” into “protocol parameters for configuring the modem.” Applicants respectfully note that “receiving modem 447” is part of the “modem module 76A” as shown in FIG. 6 of Baum, and that the “CPU 633” of Baum is not mentioned in the cited portion of Baum shown above. Applicants further respectfully note that the Final OA identified the “CPU 633” of Baum as teaching Applicants’ claimed “at least one processor,” and that Applicants’ “at least one processor” is part of the Applicants’ claimed “communication system controller,” which the Office identified as being taught by the “network application module 82” of Baum. Thus, Baum teaches that the “modem 76A” is “receiving the multi-frequency tones and is decoding the tones and converting these control signals into protocol parameters for configuration of the modem,” not the “CPU 633” of “network application module 82.” Applicants respectfully submit that the disclosure of Baum is a quite different arrangement of elements, and does not teach, suggest, or disclose the subject matter of Applicants’ claim 22, which recites “the

operational software causing the at least one processor to produce the parameters for configuring the information transmission device based upon the information requesting setup of a call.”

Applicants again respectfully submit, as noted above, that “[a] claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, **in a single prior art reference**,” and that to anticipate, “[t]he **identical** invention must be shown in as complete detail as is contained in ... the claim.” Further, “[t]he elements **must be arranged as required by the claim**....”

Applicants respectfully submit that the rejection has not demonstrated that Baum teaches at least these aspects of Applicants’ claim 22, that the Office has therefore not shown where Baum teaches each and every element of Applicants’ claim 22, as required by M.P.E.P. §2131, that claim 22 is not anticipated by Baum, and that claim 22 is allowable over Baum for at least this additional reason.

Therefore, for at least the reasons set forth above, Applicants respectfully submit that Baum does not teach, suggest, or disclose, each and every element of Applicants’ claim, as required by M.P.E.P. §2131, that Baum does not anticipate claim 22, and that claim 22, and its dependent claims, are allowable over Baum.

**With regard to claim 45**, Applicants respectfully maintain that Baum does not teach or suggest, “wherein the interface circuitry is capable of communicating digitized voice information with the information transmission device.” In rejecting claim 45, the Office states, at page 5:

**Regarding claim 45**, Baum et al. further teach wherein the interface circuitry is capable of exchanging digitized voice information with the information transmission device (see col. 5 lines 54-55; **digital data exchanged between the modem and the network application module** ; also see col. 8 lines 5-9; **calls (voice) from the call originator are digitized (digital data) and fed into the network server 30**).

(emphasis in original)

As previously discussed above with respect to claim 22, Baum does not teach, suggest, or disclose that the “modems 76a, 76b, etc.” communicate “digitized voice

information.” Applicants respectfully maintain that the “calls” received by the “modems 76a, 76b, etc.” of Baum are data calls that communicate “modem signals” that are different from “analog voice signals” or “digitized voice information,” as claimed. Therefore, Applicants respectfully submit that the “digital data” allegedly exchanged between the “modem” and the “network application module” (which the Office has identified as teachings Applicants’ claimed “information transmission device” and “interface circuitry,” respectively) is neither “analog voice signals” nor “digitized voice information.” The Office has not demonstrated where Baum teaches the communication of “digitized voice information” between the “modem” and “network application module.” **Applicants again respectfully submit that claim 45 is allowable over Baum for at least the reasons set forth above. Applicants previously requested that the Office specifically address the substance of Applicants’ arguments, should the rejection of claim 45 be maintained.**

The Final OA rejected claim 45 for exactly the same reasons presented in the Office action of June 11, 2009, but does not address the specific language of claim 45, stating at page 19, “[o]n pages 23-24 of the Applicant's remarks regarding claim 45 as previously discussed with respect to claim 22, please see response to claim 22 above.” Thus, the arguments set forth by the Office regarding claim 22 do not address the specific language of claim 45, which is different from the language of claim 22. The Advisory action also does not address Applicants’ arguments with respect to claim 45. Therefore, the Office has not addressed the specifics of claim 45, has not overcome Applicants’ argument with respect to claim 45, and has not established a *prima facie* case of anticipation with respect to claim 45. Applicants respectfully submit that claim 45 is therefore independently allowable over Baum.

Therefore, for at least the reasons set forth above, Applicants respectfully submit that Baum does not teach, suggest, or disclose each and every element of at least Applicants’ claims 22 and 45, as required by M.P.E.P. §2131, that the Office has not established a *prima facie* case of anticipation with respect to claim 22 or any claims that depend therefrom, and that claims 22 and its dependent claims are allowable over the cited art. Further, Applicants have shown that claim 45 is independently allowable over the cited art. Accordingly, Applicants respectfully request that the rejection of claims 22,



27, 28, 34, 37-40, 43, 45, and 46 under 35 U.S.C. §102(e) be reconsidered and withdrawn.

**With regard to independent claims 47 and 60**, Applicants respectfully submit that claims 47 and 60 recite features similar to those of claim 22, and are allowable over the cited art for at least some of the same reasons set forth above and during prior prosecution with respect to claim 22. Accordingly, Applicants respectfully submit that claims 47 and 60, and their depend claims, are allowable over the cited art for many of the reasons set forth above.

**With regard to claim 67**, Applicants respectfully submit that claim 67 recites, in part, “prompting the user for routing information, if routing information corresponding to the destination address is not available.” The Final OA cited Baum at col. 21, lines 54-60 as teaching this aspect of claim 67. The cited portion of Baum states the following:

Computer C1 of call originator 20 provides call set-up information, including the telephone 55 number assigned to computer C5, and transmits digital data signals representing digital data to modem M1. Assume that computer C5 is available on number 950-XXXX Modem M1 converts the set-up information and digital data to analog telephone signals on line 40.

Applicants respectfully maintain that the cited portion of Baum shown above fails to teach, suggest, or disclose prompting a user, as claimed. Instead, the cited portion of Baum teaches that “computer C1” provides “call set-up information,” which is different from and does not teach **prompting a user** “if routing information corresponding to the destination address is not available,” as required by claim 67. Thus, Applicants believe that claim 67 is independently allowable over Baum, and request reconsideration and withdrawal of the rejection of claim 67.

**In maintaining the rejection of claim 67**, the Advisory action states, in part, the following:

On page 22 of the Applicant’s remarks regarding claim 67, Applicant argues that Baum fails to teach, suggest,

or disclose prompting a user as claimed. Instead Baum teaches that computer provides call set-up information which is different than prompting a user for the routing information. The Examiner respectfully disagrees since Baum discloses the computer to provide call set-up information (control signal). The computer user may input this control signal directly (col. 2, lines 54-55). The call original [sic] may be prompted to notify what to do with the controls signals (col. 26 lines 63-64). Thus Baum discloses prompting the user for call set-up information (routing information).

Initially, Applicants respectfully remind the Office that Applicants' claim 67 recites the following:

The machine-readable storage of claim 60 wherein the determining comprises:

determining whether routing information corresponding to the destination address is available using the stored routing information and the destination address;

prompting the user for routing information, if routing information corresponding to the destination address is not available; and

refraining from prompting the user, if routing information corresponding to the destination address is available.

As shown above, the Office admits that "Baum discloses **the computer** to [sic] provide call set-up information," citing Baum at col. 2 lines 54-55. (emphasis added) Initially, Applicants respectfully submit that Baum states, at cited col. 2, lines 54-55, "[t]echniques are becoming available whereby a remote computer user may input control signals directly into the telephone line." Applicants respectfully submit that the cited portion simply states that a user inputs "control signals" directly to a telephone line, and that the Office fails to explain how and why this portion of Baum teaches that the user was "prompted" to do so, and even further, how and why the cited portion of Baum teaches prompting the user "for routing information, if routing information corresponding to the destination address is not available," as claimed.

The Advisory action also cites Baum at col. 26, lines 63-64 as support for maintaining the rejection of claim 67. This cited portion of Baum states, “[this feature allows the host computer system 60 to look up the profile of the call originator, send data or prompts to the call] originator, or whatever the user may wish to do with the control signals.” (emphasis added) Even if Applicants were to agree that Baum teaches what is asserted, namely, that “[t]he call original [sic, originator] may be prompted to notify what to do with the controls signals,” **which Applicants do not**, Applicants respectfully submit that prompting a user “to notify what to do with the controls signals” cannot be stretched so far as to teach “prompting the user for routing information, if routing information corresponding to the destination address is not available,” as claimed. Baum simply does not teach or suggest that a user might want to prompt the user for routing information, as more fully recited by claim 22. Further, there is no teaching, suggestion, or disclosure of refraining from prompting, if such “routing information” is determined to be available. Thus, for at least the above reasons, Applicants respectfully submit that claim 67 is independently allowable over the cited art.

For at least the reasons set forth above, Applicants respectfully request that the rejection of claims 47, 52-55, 57-60, and 65-69 under 35 U.S.C. §102(e) be reconsidered and withdrawn.

## **II. The Proposed Combination Of Baum And Henley Does Not Render Claims 23-25, 29-33, 44, 48-51, 56, And 61-63 Unpatentable**

Claims 23-25, 29-33, 44, 48-51, 56, and 61-63 were rejected under 35 U.S.C. §103(a) as being unpatentable over Baum in view of Henley. Applicants respectfully submit that claims 23-25, 29-33, and 44, claims 48-51 and 56, and claims 61-63 depend, respectively, from independent claims 22, 47, and 60. Applicants respectfully submit that claims 22, 47, and 60 are allowable over the cited art, in that the Office does not assert that Henley remedies any of the shortcomings of Baum, set forth above. Because independent claims 22, 47, and 60 are allowable over the cited art, Applicants respectfully submit that claims 23-25, 29-33, 44, 48-51, 56, and 61-63 that depend therefrom are also allowable, for at least the same reasons.

Accordingly, Applicants respectfully request that the rejections of claims 23-25, 29-33, 44, 48-51, 56, and 61-63 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

### **III. The Proposed Combination Of Baum, Henley And Lev Does Not Render Claims 26 And 64 Unpatentable**

Claims 26 and 64 were rejected under 35 U.S.C. §103(a) as being unpatentable over Baum and Henley, in view of Lev. Applicants respectfully submit that claims 26 and 64 depend, respectively, from claims 22 and 60. Applicants respectfully submit that claims 22 and 60 are allowable over the cited art, in that the Office does not assert that the cited art overcomes the deficiencies of Baum, set forth above. Because independent claims 22 and 60 are allowable over the cited art, Applicants respectfully submit that claims 26 and 64 that depend therefrom are also allowable, for at least the same reasons. Accordingly, Applicants respectfully request that the rejections of claims 26 and 64 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

### **IV. The Proposed Combination Of Baum And Barak Does Not Render Claim 35 Unpatentable**

Claim 35 was rejected under 35 U.S.C. §103(a) as being unpatentable over Baum in view of Barak. Applicants respectfully submit that claim 35 depends from claim 22. Applicants respectfully submit that claim 22 is allowable over the cited art, in that the Office does not show that the cited art overcomes the deficiencies of Baum, set forth above. Because independent claim 22 is allowable over the cited art, Applicants respectfully submit that claim 35 that depends therefrom is also allowable, for at least the same reasons. Accordingly, Applicants respectfully request that the rejection of claim 35 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

**V. The Proposed Combination Of Baum And Fleischer, III Does Not Render Claim 36 Unpatentable**

Claim 36 was rejected under 35 U.S.C. §103(a) as being unpatentable over Baum in view of Fleischer, III. Applicants respectfully submit that claim 36 depends from claim 22. Applicants respectfully submit that claim 22 is allowable over the cited art, in that the Office does not show that the cited art overcomes the deficiencies of Baum, set forth above. Because independent claim 22 is allowable over the cited art, Applicants respectfully submit that claim 36 that depends therefrom is also allowable, for at least the same reasons. Accordingly, Applicants respectfully request that the rejection of claim 36 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

**VI. The Proposed Combination Of Baum And Sharman Does Not Render Claim 42 Unpatentable**

Claim 42 was rejected under 35 U.S.C. §103(a) as being unpatentable over Baum in view of Sharman. Applicants respectfully submit that claim 42 depends from claim 22. Applicants respectfully submit that claim 22 is allowable over the cited art, in that the Office does not show that the cited art overcomes the deficiencies of Baum, set forth above. Because independent claim 22 is allowable over the cited art, Applicants respectfully submit that claim 42 that depends therefrom is also allowable, for at least the same reasons. Accordingly, Applicants respectfully request that the rejection of claim 42 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

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## Conclusion

In general, the Office Action makes various statements regarding the claims and the cited references that are now moot in light of the above. Thus, Applicants will not address such statements at the present time. However, Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

Applicants believe that all of pending claims 22-40 and 42-69 are in condition for allowance. Should the Examiner disagree or have any questions regarding this submission, the Applicants invite the Examiner to telephone the undersigned at (312) 775-8000.

A Notice of Allowability is courteously solicited.

The Commissioner is hereby authorized to charge any fees required by this submission to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

Dated: April 5, 2010

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